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Robert T. Andrews

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AT&T Legal Department - WK

Attn: Patent Docketing

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EXAMINER

ANTONIENKO, DEBRA L

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

02/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/738,370

Applicant(s)

ANDREWS ET AL.

Examiner

DEBRA ANTONIENKO

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-8, and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8, and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to communications received July 9, 2008, wherein:

Claims 1, 8, 15, and 16 have been amended;

Claims 3-5, and 9-11 have been cancelled; and

Claims 1, 2, 6-8, and 12-20 are pending.

Response to Amendment

2. Applicant's corrections to the specification are sufficient to overcome the objection set forth in the previous Office Action.
3. Applicant's amendments to Claim 15 are sufficient to overcome the 35 USC §101 rejection set forth in the previous Office Action.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-2, 6-8 and 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175,

184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

Here claims 1-2, 6-8 and 12-14 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim Objections

4. Claim 14 is objected to because of the following informality: dependency on Claim 9, which has been cancelled.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 16 recites the limitation "the main module." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1, 2, 6-8, 12-14, and 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn, U.S. Patent Number 6,658,192 B2 (hereinafter Glynn) in view of McDonald et al., U.S. Patent Number 6,704,030 B1 (hereinafter McDonald).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claim 1, Glynn teaches a method for provisioning a span for digital services, comprising: receiving an order for the digital services (*in response to demand*); using order data to obtain an assignment of components for the digital services; using the order data and the assignment of components to obtain equipment data; and using the order data, the assignment of components, and the equipment data to create a span design for the provision of digital services (Abstract; column 22, lines 23-28; column 24, lines 3-6).

Glynn does not explicitly teach the span design being created by selecting from a hierarchy of one or more templates, the hierarchy comprising one or more of: element templates, segment templates and architecture templates.

However, McDonald discloses the span design being created by selecting from a hierarchy of one or more templates, the hierarchy comprising one or more of: element templates, segment templates and architecture templates (column 1, lines 46-63; column 6, lines 44-46 and lines 60-63; column 7, lines 11-49; column 8, lines 11-49). It

would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Glynn with that of McDonald to use templates in order to facilitate span design.

Glynn nor McDonald explicitly teach wherein an element template represents a singular device that is defined by a function of the singular device and is later selected for inclusion into the span design based at least in part on the function of the singular device, a segment template represents a specific combination of one or more element templates that is defined, and later selected for the span design, by a problem that the segment template was created to address, and an architecture template represents a specific combination of one or more element templates and segment templates that is defined, and later selected for the span design, by a set of problems that the architecture template was created to address.

However, it is implicit that network elements are created in the first place to provide a specific function or service and are defined as such. Therefore, an element or the element template is precisely selected as part of a span design for the function or service that it provides. Similarly, network segments and architectures or topologies are constructed or have been developed in a particular way in order to resolve problems and to produce or not produce certain events. Therefore, it is obvious that one segment or architecture or topology or the respective template is selected over another precisely because of the problem it can resolve or the event it can produce or inhibit.

Regarding Claim 2, Glynn further teaches conducting an administrative review of the span design (column 24, lines 3-30 and lines 49-53).

Regarding Claim 6, Glynn further teaches wherein each component conforms to one or more rules (column 24, lines 3-30).

Regarding Claim 7, Glynn further teaches wherein conducting the administrative review of the span design, comprises checking whether each component conforms to one or more rules (column 24, lines 3-30).

Regarding Claim 8, Glynn teaches a method for creating a span design for digital services, comprising: ... receiving an order for digital services; and using order data (Abstract; column 22, lines 23-28; column 24, lines 3-6).

Glynn does not explicitly teach developing a hierarchy of one or more templates for use in creating span designs, the hierarchy comprising: element templates, segment templates and/or architecture templates.

However, McDonald discloses developing a hierarchy of one or more templates for use in creating span designs, the hierarchy comprising: element templates, segment templates and/or architecture templates ...to select one or more of the templates as a span design for the order, (column 1, lines 46-63; column 6, lines 44-46 and lines 60-63; column 7, lines 11-49; column 8, lines 11-49). It would have been obvious to one of

ordinary skill in the art at the time of the invention to modify the invention of Glynn with that of McDonald to use templates in order to facilitate span design.

Glynn nor McDonald disclose wherein an element template represents a singular device that is defined by a function of the singular device, a segment template represents a specific combination of one or more element templates that is defined by a problem that the segment template was created to address, and an architecture template represents a specific combination of one or more element templates and segment templates that is defined by a set of problems that the architecture template was created to address; wherein an element template is selected for the span design based on the function of the device, a segment template is selected for the span design based on the problem that the segment template was created to address, and an architecture template is selected for the span design based on the set of problems that the architecture template was created to address.

However, it is implicit that network elements are created in the first place to provide a specific function or service and are defined as such. Therefore, an element or the element template is precisely selected as part of a span design for the function or service that it provides. Similarly, network segments and architectures or topologies are constructed or have been developed in a particular way in order to resolve problems and to produce or not produce certain events. Therefore, it is obvious that one segment or architecture or topology or the respective template is selected over another precisely because of the problem it can resolve or the event it can produce or inhibit.

Regarding Claim 12, Glynn further teaches using the order data and an assignment of components as the span design for the order (Abstract; column 22, lines 23-28; column 24, lines 3-6). McDonald teaches to select the one or more templates (column 6, lines 44-46 and lines 60-63; column 8, lines 11-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Glynn's invention to incorporate McDonald's use of templates as building blocks in order to facilitate span design. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to use order data and an assignment of components for creating span designs.

Regarding Claim 13, Glynn further teaches using the order data, the assignment of components, and equipment data as the span design for the order (Abstract; column 22, lines 23-28; column 24, lines 3-6). McDonald further teaches to select the one or more templates (column 6, lines 44-46 and lines 60-63; column 8, lines 11-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Glynn's invention to incorporate McDonald's use of templates as building blocks in order to facilitate span design. Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to use order data, the assignment of components, and equipment for creating span designs.

Regarding Claim 14, Glynn further teaches wherein each component conforms to one or more rules (column 24, lines 3-30).

9. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn, U.S. Patent Number 6,658,192 B2 (hereinafter Glynn).

Regarding Claim 15, Glynn teaches a system for the provision of a span design for digital services, comprising: an assignment control system (ACS) executing within one or more computing devices (*software system*); an inventory module (IM) executing within the one or more computing devices (*reference database*); and a main server (*processor*), wherein the main server receives an order for the digital services from a user and provides order data from the order to the assignment control system (ACS), wherein the main server receives assignment data from the ACS, the assignment data identifying one or more components for the digital services... and forwards the assignment data to an inventory module (IM) which uses the assignment data to determine equipment data based at least in part on the assignment data, and wherein the main server receives the equipment data from the IM and processes the order data, the assignment data, and the equipment data to create the span design for the digital services (Abstract; column 22, lines 23-28; column 24, lines 3-6; Figure 26).

Glynn does not explicitly teach each component being associated with one of one or more specific problems concerning the provision of the digital services and a device functionality, ...by selecting a combination of one or more components based on the

one or more specific problems and device functionalities concerning the provision of the digital services being ordered.

However, it is implicit that components are created in the first place to provide a specific function or service and are defined as such. Components are constructed or have been developed in a particular way in order to resolve problems as well. A component is precisely selected as part of a span design for the function or service that it provides. Therefore, it is obvious that one component is selected over another precisely because of the functionality it was designed to provide or the problem it can resolve.

Regarding Claim 16, McDonald further teaches wherein the main module creates the span design based on templates created from a combination of predefined components (column 1, lines 46-63; column 6, lines 44-46 and lines 60-63; column 7, lines 11-49; column 8, lines 11-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Glynn with that of McDonald to use templates in order to facilitate span design.

Regarding Claim 17, McDonald further teaches wherein the templates comprise: one or more element templates; one or more segment templates; or one or more architecture templates (column 6, lines 44-46 and lines 60-63; column 8, lines 11-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Glynn with that of McDonald to use templates in order to facilitate span design.

Regarding Claim 18, McDonald further teaches wherein a template comprises a representation of the one or more components for the digital services (column 6, lines 44-46 and lines 60-63; column 8, lines 11-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Glynn with that of McDonald to use templates in order to facilitate span design.

Regarding Claim 19, McDonald further teaches wherein components used for implementation of the digital services are hierarchically organized based on elements, segments, and/or architectures (column 1, lines 15-22; column 7, lines 27-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Glynn with that of McDonald to use templates in order to facilitate span design.

Regarding Claim 20, Glynn further teaches wherein each of the components comply with one or more rules (column 24, lines 3-30).

Response to Arguments

10. Applicant's arguments filed July 9, 2008 have been fully considered but they are not persuasive.

In response to Applicant's assertion that McDonald fails to cure the *discrepancies in Glynn by describing that the span design is created based on a hierarchy of the*

components (Applicant's Response, July 9, 2008, page 7), Examiner respectfully disagrees. As cited in the previous Office Action, McDonald discloses that *[t]he network elements are typically housed in equipment buildings and are organized in bays within the building. Each bay may include several shelves of equipment, with each shelf including one or more circuit packs. Each circuit pack, in turn, may provide for communications through several included ports. Communications through each port may be divided into several tributaries and the type of communications may be further divided* (column 1, lines 15-22). Going from bays to circuit packs to ports to tributaries demonstrates a hierarchy. Furthermore, as cited in the previous Office Action, McDonald discloses that *[t]he interactive provisioning system may allow a user to supply such information... through a selection tree at the user's option... known controls that allow hierarchically-related objects to be displayed...*(column 7, lines 27-35).

In response to Applicant's assertion that *McDonald is silent concerning any functionality* (page 8), which includes the amended independent Claim 1 (page 9), the amended independent Claim 8 (pages 11-12), and the amended independent Claim 15 (pages 9-10), Examiner notes that it is implicit that network elements are created in the first place to provide a specific function or service and are defined as such. Therefore, an element or the element template is precisely selected as part of a span design for the function or service that it provides. Similarly, network segments and architectures or topologies are constructed or have been developed in a particular way in order to resolve problems and to produce or not produce certain events. Therefore, it is obvious that one segment or architecture or topology or the respective template is selected over

another precisely because of the problem it can resolve or the event it can produce or inhibit.

Furthermore, a reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art. *In re Delisle*, 160 USPQ 806 (CCPA 1969).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is

(571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
February 1, 2009